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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,399	06/12/2001	Travis J. Parry	10011064-1	7135

7590 05/19/2005

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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SON, LINH L D

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/880,399

Applicant(s)

PARRY ET AL.

Examiner

Linh LD Son

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 June 2001.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,9-14 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,9-14 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This written action is responding to the amendment dated 02/03/05.
2. Claims 1 and 10 are amended. Claims 6-8 and 15-17 are canceled.
3. Claims 1-5, 9-14, and 18 are pending.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, 9-14, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dietl et al, US Publication No. 20020063760A1, hereinafter "Dietl" in view of Outwater, US Patent No. 6612494B1.
6. As per claims 1 and 10, Dietl discloses "A method for self-authenticating a marking agent cartridge, wherein said method is comprised of the steps of: installing an identification means on a marking agent cartridge" in (Para 0015); "installing said cartridge in a printer; automatically reading said identification means on said cartridge by said printer; determining if said cartridge is a counterfeit by automatically reading said identification means on said cartridge by said printer in order to obtain second information regarding said identification means; and comparing said first information of said identification means with said second information of said identification means" in

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(Para 0017-0018); and "accepting/rejecting said cartridge by accepting said marking agent cartridge as being genuine if said first information of said identification means substantially matches said second information of said identification means; and rejecting said marking agent cartridge as being counterfeit if said first information of said identification means does not substantially match said second information of said identification means" in (Para 0019-0021).

However, Dietl is silent on "forwarding first information regarding said identification means to a database and compiling said first information in said database";

Nevertheless, Outwater discloses the "Product Authentication System" invention, which including a marking method similar to Dietl, such as using label and barcode (Col 5 lines 5-18). Outwater also teach of compiling the marking information to a database utilizing for authenticating a product (Figure 4, Col 5 lines 20-33, Col 7 lines 49-59, Col 8 line 53 to Col 9 line 10, and Col 9 lines 35-67). Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modify Dietl's invention to incorporate Outwater's method to provide a secure and reliable method to authenticate a cartridge when installing to a printer.

7. As per claims 2 and 11, Dietl discloses "The method, as in claims 1 and 10, wherein said marking agent is further comprised of: toner" in (Para 0017).

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8. As per claims 3 and 12, Dietl discloses "The method, as in claims 1 and 10, wherein said marking agent is further comprised of: ink" in (Para 0017).

9. As per claims 4-5 and 13-14, Dietl discloses "The method, as in claims 1 and 10, wherein said identification means is further comprised of: a bar code and a label" in (Outwater, Col 5 lines 8-13).

10. As per claims 9 and 18, Dietl discloses "The method, as in claim 1". However, Dietl is silent on "the step of notifying a producer/supplier of said marking agent cartridge if said marking agent cartridge is rejected as being counterfeit". Nevertheless, Outwater does teach a step of notifying a field operator the result of the authentication in (Col 9 lines 63-67). Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modify Outwater's method to notify only when a comparison is not equal to provide a full control of an ink cartridge installed in the printer.

### ***Response to Amendment***

11. Applicant has amended the independent claims 1 and 10, which necessitated new grounds of rejection. See Rejections above.

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***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

**Conclusion**

13. Any inquiry concerning this communication from the examiner should be directed to Linh Son whose telephone number is (571)-272-3856.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Kim Y. Vu can be reached at (571)-272-3859. The fax numbers for this group are (703)-872-9306 (official fax). Any inquiry of general nature or relating to the

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status of this application or proceeding should be directed to the group receptionist whose telephone number is (571)-272-2100.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIR.I system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PMR only. For more information about the PAIR system, see <http://pzr-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*HS*  
*AV 2135*

**Linh LD Son**

**Patent Examiner**